

REMARKS

In response to the Office Action dated 22 December 2004, the applicant requests reconsideration of the above-identified application in view of the following remarks. Claims 1-25 are pending in the application, and are rejected. Claims 1, 12, and 24 will be amended upon entry of the present amendment.

Information Disclosure Statement

The applicant filed an Information Disclosure Statement on 4 March 2002. The applicant respectfully requests entry of that Information Disclosure Statement and requests that the documents listed on the attached Form 1449 be considered by the Examiner and made of record. Pursuant to the provisions of MPEP 609, the applicant requests that a copy of the 1449 form, initialed as being considered by the Examiner, be returned to the applicant with the next official communication.

Claim Amendments

Claims 1, 12, and 24 are amended herein to provide a proper antecedent basis for some claim elements, and are not amended in response to the prior art rejection. No new matter has been added. This is not a narrowing amendment.

Rejection of Claims Under §112

Claim 1 was rejected under 35 USC § 112, second paragraph. The applicant respectfully traverses.

Claim 1 will be amended upon entry of the present amendment to obviate the rejection.

Rejection of Claims Under §103

Claims 1-25 were rejected under 35 USC § 103(a) as being unpatentable over Joyce et al. (U.S. 6,798,358, Joyce) in view of Carey et al. (U.S. 6,714,793, Carey). The applicant respectfully traverses.

Joyce issued on September 28, 2004, which is after the 28 August 2001 filing date of the present application. The applicant does not admit that Joyce is prior art, and reserves the right to swear behind Joyce at a later date.

Carey issued on March 30, 2004, which is after the 28 August 2001 filing date of the present application. The applicant does not admit that Carey is prior art, and reserves the right to swear behind Carey at a later date.

The MPEP requires a suggestion and a reasonable expectation of success for a rejection under 35 USC § 103:

“To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.”¹

The suggestion or motivation to combine references and the reasonable expectation of success must both be found in the prior art.²

Joyce relates to location-based content delivery³ to a mobile terminal 10 serviced by a wireless communication network 12.⁴ The Office Action states:

“Joyce does not disclose that the messages that are delivered are instant messages.”⁵

Carey relates to a method and system for instant messaging.⁶

The Office Action states:

“it would have been obvious ... to modify the system disclosed by Joyce to include instant messaging capabilities in order to provide subscribers with the benefits of real-time communication not only in hardwired Internet systems but also in a wireless environment. It would be advantageous to communicate via instant text messages because it is less costly and it utilizes less bandwidth.”⁷

¹ MPEP 2143.

² MPEP 2143.

³ Joyce, Title.

⁴ Joyce, column 3, lines 6-15.

⁵ Office Action, page 3.

⁶ Carey, Title.

⁷ Office Action, pages 3 and 4.

The Office Action has not identified prior art as being the source of the above-quoted rationale for combining Joyce and Carey as is required by MPEP 2143. As an example, the Office Action has not identified prior art showing that communicating with instant text messages is less costly and utilizes less bandwidth. A general reference to the teachings of Carey is not a specific suggestion or motivation. The MPEP cited *In re Lee* as:

“discussing the importance of relying on objective evidence and making specific factual findings with respect to the motivation to combine references.”⁸

The Office Action has also not identified a reasonable expectation of success for this combination in the prior art as is required by MPEP 2143.

With regard to claims 12-21 and 25, neither Joyce nor Carey show or describe the claimed hotspot-access point. The Office Action states that “the hotspot access point is functionally equivalent to the wireless communication network 12.”⁹ The Office Action has not identified prior art evidence as being the source of this assertion as is required by MPEP 2143 and MPEP 2143.01.

The applicant respectfully submits that a *prima facie* case of obviousness against claims 1-25 has not been established in the Office Action, and that claims 1-25 are in condition for allowance.

⁸ MPEP 2143.01, page 2100-130.

⁹ Office Action, page 6.

CONCLUSION

The applicant respectfully submits that all of the pending claims are in condition for allowance, and such action is earnestly solicited. The Examiner is invited to telephone the below-signed attorney at 612-373-6973 to discuss any questions which may remain with respect to the present application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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By his Representatives,

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Date 22 March 2005

By _____

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Name

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Signature



CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail, in an envelope addressed to: MS Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on this 22nd day of March, 2005.